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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Finnegan, Henderson, Farabow,
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1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/059,155	GEFFROY, NATHALIE	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-152 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed. 143
- 6) ☒ Claim(s) 1-3,5,8,10,15-28,30,32-66,68-73,75,78,80,85-98,100,102-114,116,119,121,126-139,141-152 is/are rejected. 143
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 4,6,7,9,11-14,29,31,67,74,76,77,79,81-84,99,101,115,117,118,120,122-125,140 and 142.

Art Unit: 1617

DETAILED ACTION

Receipt of applicants' remarks submitted February 17, 2004 is acknowledged.

Claim Rejections 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 8, 10, 15-28, 30, 32-66, 68-73, 75, 78, 80, 85-98, 100, 102-114, 116, 119, 121, 126-139, 141, and 142-152 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leverett (US 6,299,891, IDS), in view of Ethox Chemicals (IDS).
3. Leverett teaches a cosmetic composition comprising a "plasticizer" and a metal soap, wherein the "plasticizer" is any of water soluble plasticizers, the most preferred "plasticizers" include polyethylene glycol, and polyethylene glycol esters; and the preferred metal soap is sodium stearate. See, particularly, column 1, line 66 to column 2, lines 5. column 2, lines 42-51. The amount of the "plasticizer" is in the range of 0.5% to 25% by weight, and preferred 5%-20%, and most preferred 7-10%. Column 2, lines 25-28. The amount of metal soap is about 2-15%, preferred 3-10%, and most preferred 4-8%. See, column 2, lines 59-62.
4. Leverett does not teach expressly the particularly combination of the particular PEG ester, PEG 150 dibehenate and sodium stearate.
5. However, Ethox chemical teaches that PEG 150 dibehenate is particular made for personal care product known as superior viscosity builder, excellent viscosifier for both aqueous

Art Unit: 1617

and aqueous-alcohol system, cost effective building block for gel formulations, and providing 'after-feel' and conditioning in skin care and ethnic hair care products. See the entire document.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the PEG 150 dibehenate as the "plasticizer" in Leverrett's cosmetic composition.

A person of ordinary skill in the art would have been motivated to employ the PEG 150 dibehenate as the "plasticizer" in Leverrett's cosmetic composition because of the known superiorities of PEG 150 dibehenate. Further, the optimization of a result effective parameter, e.g., amounts of each of the ingredients, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

6. Claims 1-3, 5, 8, 10, 15-28, 30, 32-66, 68-73, 75, 78, 80, 85-98, 100, 102-114, 116, 119, 121, 126-139, 141, and 142-152 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ethox Chemicals (IDS), in view of Kasat et al (US 6,165,480, IDS).

7. Ethox chemical teaches that PEG 150 dibehenate is particular made for personal care product known as excellent viscosifier for both aqueous and aqueous-alcohol system, cost effective building block for gel formulations, cost effective building block for gel formulations, and providing 'after-feel' and conditioning in skin care and ethnic hair care products. See the entire document.

8. Ethox chemical does not teaches expressly a cosmetic composition comprising fatty acid gellant, such as sodium stearate, and the PEG 150 dibehenate, or adding the PEG 150 dibehenate to a cosmetic composition comprising the metal soap.

Art Unit: 1617

9. However, Kasat et al. discloses that sodium stearate, as, well as other metal soap are known gelling agent in cosmetic product.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a cosmetic gel composition comprising both sodium stearate and PEG 150 dibehenate.

A person of ordinary skill in the art would have been motivated to make a cosmetic gel composition comprising both sodium stearate and PEG 150 dibehenate because it is prima facie obvious to combine two compositions each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known gel forming agents sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. Further, the optimization of a result effective parameter, e.g., amounts of each of the ingredients, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Furthermore, the employment of other well-known cosmetic ingredients, such as water, in the composition is obvious since PEG 150 dibehenate is particularly known to be useful with water.

10. Claims 1-3, 5, 8, 10, 15-28, 30, 32-66, 68-73, 75, 78, 80, 85-98, 100, 102-114, 116, 119, 121, 126-139, 141, and 142-152 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuo et al. (JP 2002-003891), in view of Ethox Chemicals (IDS).

11. Katsuo et al. teaches a hair and body cleansing composition comprising A) a compounds of RBXBR, wherein R is a hydrophobic moiety, and X is hydrophilic moiety, and B is ether,

Art Unit: 1617

ester, or urethane linkage, and B) an anionic surfactant, which may be an metal salt of fatty acid, wherein the metal ion may be an alkali metal. See particularly, the abstract.

12. Katsuo et al. does not teach expressly a particular combination of sodium stearate and PEG 150 dibehenate.

13. However, Ethox chemical teaches that PEG 150 dibehenate is particular made for personal care product known as superior viscosity builder, excellent viscosifier for both aqueous and aqueous-alcohol system, cost effective building block for gel formulations, and providing 'after-feel' and conditioning in skin care and ethnic hair care products. See the entire document.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a composition according to Katsuo, wherein the first agent is PEG 150 dibehenate, and the anionic surfactant is sodium stearate. A person of ordinary skill in the art would have been motivated to make a composition according to Katsuo, wherein the first agent is PEG 150 dibehenate, and the anionic surfactant is sodium stearate because PEG 150 dibehenate is particularly known for its superiorities as cosmetic ingredients. The employment of sodium stearate is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2nd 1387 (at 1388). Further, the optimization of a result effective parameter, e.g., amounts of each of the ingredients, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Furthermore, the employment of other well-known cosmetic ingredients, such as water, in the composition is obvious since PEG 150 dibehenate is particularly known to be useful with water.

Art Unit: 1617

Response to the Arguments

Applicants' remarks submitted February 17, 2004 have been fully considered, but are not persuasive.

14. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teachings, suggestion and motivation are found both in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Leverett teaches the usefulness of combination of metal soap with polyethylene glycol ester generally, Ethox teaches the various advantage of ETHOX P-600, as discussed above, the combination of ETHOX P-600 with the other references is clearly motivated. Further, absent benefit unobvious over the prior art, there is no issue of "obvious to try."

15. Applicants further contend that the cited references teach away from claimed invention because both metal soap and PEG 150 are viscosity builder, therefore, there are is no need to combined the two. The arguments are not convincing. Particularly, note PEG 150 is known for many advantages in cosmetic composition, increasing viscosity is merely one of them. One of ordinary skill in the art would have been motivated to fully utilize the advantage of PEG- 150.

16. As to the remarks regarding the rejections over Ethox Chemicals and Kasat et al, Applicants again allege that there is no motivation to combine two agents with the same

Art Unit: 1617

function. These is not persuasive, particularly in view of In re Kerkhoven, 205 USPQ 1069, where it is well established that the idea of combining two agent with same function flows logically from their having been individually taught in prior art.

17. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In instant case, the cited references provide direction, motivation to arrive the claimed invention.

18. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., emulsion or multiemulsion) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1617


the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

**SHENGJUN WANG
PRIMARY EXAMINER**


Shengjun Wang

April 24, 2004